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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,752	02/25/2005	Jean-Francois Stumbe	12810-00019-US	9925

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EXAMINER
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ACQUAH, SAMUEL A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/525,752

Applicant(s)

STUMBE ET AL.

Examiner

SAMUEL A. ACQUAH

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 05/25/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-15 and 21-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Meixner et al 4,983,712 and Sorensen et al 6,093,777.

Both of the cited prior arts disclose methods for preparing compositions comprising polyester comprising at least one dicarboxylic acid reacted with at least one polyether polyol which is an alkoxyated polyol, under conditions as claimed, and the compositions have uses as claimed. See column 2, lines 1-6, and 62-68; and column 3, line 1 et seq. of the '712. Also, see column 8, lines 15-27; column 9, lines 22-67, and Examples 1-4 in columns 13-15 of the '777.

3. Claims 1-9, 12-15, and 21-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Beck et al 5,096,938.

Beck et al disclose process and composition for radiation-curable acrylates comprising the reaction product of a polyether polyol and a dicarboxylic acid in the presence of a catalyst. The composition is useful as a coating agent. See the abstract and column 2, line 9 et seq., and Examples 1-4.

4. Claims 1-11, and 21-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Lincoln 2,807,606.

This prior art discloses condensation polymers and their intermediates and their methods of preparation. The process comprises the preparation of a polyester comprising a polyether polyol reacted with a dicarboxylic acid under conditions as claimed. See columns 2-6, starting from line 26 of column 2 through line 34 of column 6.

5. Claims 1-10, and 21-29 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2 259 514.

This prior art discloses a coating composition and its method of preparation comprising a hydroxyl group-containing polyester resin having features and characteristics as claimed. See pages 14-19.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '514.

The disclosures of this prior art are as discussed supra. Patentees teach the use of chain extenders and chain stoppers as claimed. See pages 20 and 21. It is the Examiner's position that the use of claimed extenders and stoppers as claimed would have been obvious based on the teachings of the prior art.

8. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB '514 or any of Meixner et al., Beck et al or Sorensen et al in view of DE 101 631 64.4 or DE 102 195 08.0.

The disclosures of the primary references are as discussed above. None of said references disclose the use of enzyme catalyst in the preparation of the polyesters; however, it is the Examiner's position that said would have been well within the limit of skills of the ordinary practitioner in view of the secondary references which disclose the use of enzyme catalysts in processes for preparing hyperbranched polyesters.

9. Claims 28 and 29 provides for the use of the polyesters, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 28 and 29 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

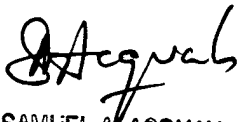
10. Other references listed on PTO-1449 have been made part of the record.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL A. ACQUAH whose telephone number is 571-272-1065. The examiner can normally be reached on M-TH, FRIDAYS OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES SEIDLECK can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.A.A.  
01/09/06

  
SAMUEL A. ACQUAH  
PRIMARY EXAMINER  
GROUP ~~120~~ 1700